

Remarks

I. Summary of Office Action

Claims 1-20 are pending in the above-identified application.

Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting.

Claims 1-4, 9-12, and 17-20 are finally rejected under 35 U.S.C. §102(e) as being anticipated by Hendricks et al., U.S. Pat. No. 5,798,785 (hereinafter "Hendricks"). Claims 5, 6, 8, 13, 14, and 16 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Hendricks in view of Levine, U.S. Pat. No. 5,692,214 (hereinafter "Levine"). Claims 7 and 15 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Hendricks in view of Hashimoto, U.S. Pat. No. 5,179,439 (hereinafter "Hashimoto").

Applicants respectfully traverse the Examiner's rejections.

II. Summary of Telephonic Interview

The Examiner and applicants' representative, Michael J. Chasan (Reg. No. 54,026), conducted a telephonic interview on October 23, 2008. During the interview, the Examiner and applicants' representative discussed the claims and the Hendricks reference. The substance of the interview will be described briefly in this section and will be argued in greater detail below.

Generally speaking, applicants' independent claims are directed to an interactive program guide (IPG) that automatically generates a set of favorite criteria about television programs that may interest a viewer. The IPG then searches for television programs that include these criteria, tags the programs, then activates a function related to the tagged programs without the viewer's intervention. Some examples of the IPG activating a function related to tagged television programs include automatically placing a reminder to watch a tagged program, automatically scheduling a recording of a tagged program, and automatically downloading a tagged program for storage (Specification, p. 22, lines 28-31).

Applicants maintain that these independent claims are not anticipated by Hendricks for at least the reason that Hendricks does not show activating a function related to the tagged programs without the viewer's intervention.

In the Office Action and during the interview, the Examiner cited the following lines from Hendricks:

The microprocessor 602 will then select one or more programs to suggest to the subscriber based on the results of the abstract search. These suggested programs will then be displayed on the menu for viewer selection. (Hendricks, col. 30, ll. 47-50)

The Examiner argued that this portion of Hendricks shows displaying a menu of suggested programs without viewer intervention. Applicants disagree.

During the interview applicants demonstrated that a close reading of Hendricks contradicts the Examiner's interpretation of the cited portion of Hendricks. In fact, there is nothing in Hendricks that shows or suggest that suggested programs are displayed (or that any other functions are activated) without viewer intervention. This will be discussed in greater detail below.

The Examiner agreed to reconsider the rejection in view of the Interview and this Reply to Final Office Action. Applicants and applicants' representative wish to thank the Examiner for the courtesy extended during this interview.

III. The Double-Patenting Rejections of Claims 1-20

Claims 1-20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Pat. No. 6,732,369 B1 to Schein et al.* The Examiner should continue to make this double patenting rejection as long as there are conflicting claims, unless the double patenting rejection is the only rejection remaining in this application. If the double patenting rejection is the only rejection remaining in this application, applicant will then submit a Terminal Disclaimer.

* The Office Action states on page 4: "This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented." Applicants assume that this is a mistake. The double patenting rejection has been made over an issued patent (U.S. Pat. No. 6,732,369). Therefore this is not a *provisional* double patenting rejection.

IV. The 35 U.S.C. §102(c) Rejections of Claims 1-4, 9-12, and 17-20

A. Hendricks' "Preferred" Embodiment

Hendricks discloses several embodiments of set top terminals for a television program delivery system which suggests programs for viewing. In the first or "preferred" embodiment, the subscriber "provide[s] responses to the set top terminal 220 by selecting preference entries indicative of the subscriber's programming preferences" by, for example, using a remote control (Hendricks, col 30 lines 34-39). After the subscriber has selected his or her preferences, the system will then perform a search (*id.*, lines 43-44), select one or more of the programs resulting from the search to suggest to the subscriber, then display the suggested programs on the menu (*id.*, lines 47-50). Applicants particularly note that the program search is performed upon receipt of input from the user. For example, as mentioned above, the subscriber must "provide responses to the set top terminal" (*id.*, lines 34-35). Hendricks further reinforces this point by stating that the program search commences "after the viewer has selected as many of the [preferences] entries as desired, and then hits the 'go' button or alternatively selects by cursor or highlight a 'go' menu item" (*id.*, col. 32 lines 20-24). In addition, Hendricks also specifies that "[i]f the viewer desires to view a list of all these selections . . . the viewer may select the VIEW option," (*id.*, lines 33-35) and "the viewer can . . . select the desired movie by clicking on the desired program" (*id.*, lines 38-40). Therefore, Hendricks' preferred embodiment requires that the subscriber (a) manually provide responses indicative of preferences, (b) manually initiate program search, (c) manually choose the VIEW option to see the resulting list, and (d) manually select the desired program. In contrast, Applicants' claimed invention is directed to automatically generating criteria, searching for programs, and activating a program-related function, without viewer intervention.

The Examiner argues that the following portion of Hendricks shows displaying a menu of suggested programs without viewer intervention:

The microprocessor 602 will then select one or more programs to suggest to the subscriber based on the results of the abstract search. These suggested programs will then be displayed on the menu for viewer selection. (Hendricks, col. 30, ll. 47-50)

However, Applicants note that this passage merely provides an overview of Hendricks' "preferred" embodiment, which is described in further detail in subsequent paragraphs in Hendricks, and which Applicants have already summarized. Applicants therefore submit that the portion of Hendricks cited by the Examiner was taken out of context, and does not show displaying a menu of suggested programs without viewer intervention. Furthermore, even assuming *arguendo* that Hendricks does show displaying a menu of suggested programs without viewer intervention, Applicants submit that performing such an action without a viewer's intervention is inconceivable. Displaying suggested programs without a viewer's intervention would result in a disruptive system that would unpredictably show programs to a viewer, even when the viewer is trying to watch a television program. Such a system would, at best, be a nuisance to a viewer, and, in a more likely scenario, would actually prevent a viewer from even watching television programs. Therefore, Applicants submit that Hendricks' "preferred" embodiment does not show displaying programs (or activating other functions) without viewer intervention.

B. Hendricks' Other Embodiments

Hendricks also discloses other program suggestion system embodiments. Applicants note, however, that none of these embodiments display suggested programs (or activate other functions) without viewer intervention. For example, one embodiment calls for the establishment of a favorite channel list "based on responses to inquiries" (*id.*, col 33 lines 15-16). Another embodiment allows the utilization of favorite channels and often-watched channel features during menu selection by the user (*id.*, lines 27-29). In yet another embodiment, the system "display[s] a customized submenu allowing the subscriber to choose one of the suggested popular shows" (*id.*, lines 40-42). In one particular embodiment, the terminal may "learn" personal profile information and use this information to generate a list of suggested programs without user profile input (*id.*, col 35 line 9 to col 37 line 13). Applicants note, however, that in order to display the list of suggested programs, the viewer must still actuate a VIEW option as described previously (*id.*, col 32 lines 33-35).

C. Conclusion

For at least the foregoing reasons, Applicants submit that Hendricks does not show each and every element of Applicants' independent claims. Therefore, the 35 U.S.C. §102(c) rejections of independent claims 1, 9, and 17 should be withdrawn. Similarly, the 35 U.S.C. §102(c) rejections of claims 2-4, 10-12, and 18-20, which depend from independent claims 1, 9, and 17 and add further limitations thereto, should be withdrawn.

V. The 35 U.S.C. §103(a) Rejections of Claims 5, 6, 8, 13, 14, and 16

Claims 5, 6, 8, 13, 14, and 16 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Hendricks in view of Levine.

Claims 5, 6, 8, 13, 14, and 16 each depend from one of independent claims 1 and 9, and recite that the function activated without viewer intervention is: automatically tuning to a tagged television program (claims 5 and 13), automatically programming a recording device to record a tagged television program (claims 6 and 14), or automatically downloading a copy of the tagged program to a digital storage medium (claims 14 and 16). Applicants submit that the combination of Hendricks and Levine do not show or suggest all of the elements of claims 5, 6, 8, 13, 14, and 16.

The Examiner concedes that Hendricks does not teach a system where the tagged program is automatically tuned to, programmed for recording, or downloaded (Action, p. 6 and 7). In an attempt to remedy this deficiency in Hendricks, the Examiner suggests combining Hendricks with Levine.

Levine refers to a system for recording programs. A computer receives a schedule of future programs, and a user selects a particular program to be scheduled for recording. The selected program is recorded at the appropriate time (Levine, abstract).

Applicants note that the system of Levine requires viewer intervention in the form of a viewer selection in order to pick a program to record. As mentioned previously, Hendricks does not show activating program-related functions without viewer intervention. Thus, Levine fails to make up for the deficiencies in Hendricks, and the combination of Hendricks and Levine fails to show

activating program-related functions without viewer intervention, as recited in Applicants' claimed invention. For at least the foregoing reason, the 35 U.S.C. §103(a) rejections of claims 5, 6, 8, 13, 14, and 16 should be withdrawn.

V. The 35 U.S.C. §103(a) Rejections of Claims 7 and 15

Claims 7 and 15 are finally rejected under 35 U.S.C. §103(a) as being unpatentable over Hendricks in view of Hashimoto, U.S. Pat. No. 5,179,439 (hereinafter "Hashimoto").

Claims 7 and 15 depend from independent claims 1 and 9, respectively, and recite that the function activated without viewer intervention is automatically reminding the viewer to view a tagged television program. Applicants submit that the combination of Hendricks and Hashimoto do not show or suggest all of the elements of claims 7 and 15.

The Examiner concedes that Hendricks does not teach a system that automatically reminds the viewer of a tagged program (Action, p. 8). In an attempt to remedy this deficiency in Hendricks, the Examiner suggests combining Hendricks with Hashimoto.

Hashimoto refers to a system for reserving television programs. A user manually enters television programs that he desired to record into the system (Hashimoto, col 5 lines 38-39). When it is time for the television program to be aired, an alarm is sounded so the user can manually switch the VCR to a recording mode (*id.*, col 6, lines 15-26).

Applicants note that the system of Hashimoto requires viewer intervention in the form of manually switching the VCR to a recording mode. As mentioned previously, Hendricks does not show activating program-related functions without viewer intervention. Thus, Hashimoto fails to make up for the deficiencies in Hendricks, and the combination of Hendricks and Hashimoto fails to show activating program-related functions without viewer intervention, as recited in Applicants' claimed invention. For at least the foregoing reason, the 35 U.S.C. §103(a) rejections of claims 7 and 15 should be withdrawn.

VI. Conclusion

In view of the foregoing, Applicants believe that the pending application is in condition for allowance. Reconsideration and allowance are respectfully requested.

Applicants believe no fee is due with this response other than as indicated in the enclosed Amendment Transmittal. However, if a fee is due, please charge our Deposit Account No. 06-1075, under Order No. ST-027 Cont. from which the undersigned is authorized to draw.

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Respectfully submitted,

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